The opinion in support of the decision being entered today was *not* written
for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEVEN M. GOLDEN, HILLEL LEVIN,
GARY D. GENTRY, JAMES A. BARBOUR,
ALBERT SCHORNBERG and BRADLEY A. ANDERSON

Appeal No. 2006-0280
Application No.09/490,362

HEARD: June 6, 2006

Before OWENS, LEVY, and NAPPI, *Administrative Patent Judges*
OWENS, *Administrative Patent Judge.*

DECISION ON APPEAL

This appeal is from a rejection of claims 61-63, which are all of the pending claims.

THE INVENTION

The appellants claim a process for distributing and automatically redeeming coupons.

Claim 61 is illustrative:

61. A process for distributing and redeeming coupons, comprising the steps of:

establishing electrical communication over the Internet between a service
system and a plurality of remote users having personal computers;

receiving at the service system from a plurality of issuer systems

instructions for issuing the redeemable coupons;

　　　receiving at the service system profile data input by the remote users over the Internet;

　　　the service system permitting remote user access to offers for redeemable coupons upon the entry of profile data requested of the remote users by the service system;

　　　said offers being accessible over the Internet to selective remote users based on analysis of the profile data;

　　　storing coupon files in a data base, said coupon files containing information relating to redeemable coupons offered to and selected by the remote user; and

　　　automatically redeeming coupons contained in said stored data base when the remote users make transactions using a credit card.

THE REFERENCES

Bezos	5,715,399	Feb. 03, 1998
Golden et al. (Golden)	5,761,648	Jun. 02, 1998
Barnett et al. (Barnett)	6,336,099	Jan. 01, 2002
		(effective filing date Apr. 19, 1995)
Levin et al. (Levin)	2003/0200146	Oct. 23, 2003
		(effective filing date Apr. 13, 1999)

THE REJECTIONS

Claims 61-63 stand rejected as follows: under the judicially created doctrine of obviousness-type double patenting over 1) claims 1-16 of Golden in view of Barnett and Bezos, and 2) claims 1-16 of Levin in view of Barnett and Bezos;[1] and under 35 U.S.C. § 103 as obvious over Barnett in view of Bezos.

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[1] The examiner's rejection is over U.S. patent application no. 10/438,582 (and, therefore, should have been a provisional obviousness-type double patenting rejection). U.S. patent application no. 10/438,582 has issued as the

OPINION

We affirm the obviousness-type double patenting rejections and reverse the rejection

under 35 U.S.C. § 103.

Obviousness-type double patenting rejections

The appellants do not challenge the obviousness-type double patenting rejections but,

rather, state that the appellants have agreed to provide terminal disclaimers (brief, pages 15-17).

Accordingly, we summarily affirm the obviousness-type double patenting rejections.

Rejection under 35 U.S.C. § 103

The appellants' sole independent claim (61) requires "automatically redeeming coupons

contained in said stored database when the remote users make transactions using a credit card."

For a disclosure of automatic redemption the examiner relies upon Barnett (answer, page

5). The relevant portion of Barnett is as follows (col. 11, lines 30-44):

> Thus, the printable coupon data generation routine **32d** combines all this information and generates a record indicative of the unique coupon to be printed. This record is temporarily stored in the output buffer **28**, where it is subsequently sent to the printer **8** for printing. In the alternative, the coupon may be redeemed electronically by sending the coupon data in the output buffer via the data communications interface **20** back to the online service provider **2**. This is especially useful in the "electronic shopping mall" environment now found in many online services. The electronic coupon data could also be routed via the data communications interface **20** to a retail store where the user will be shopping, where the coupon data is held in a buffer pending purchase by the user of the matching product.

Levin patent. Consequently, we treat the rejection as an obviousness-type double patenting rejection over Levin in view of Barnett and Bezos.

The examiner argues that in this disclosure the coupons are redeemed "electronically/automatically" (answer, page 5). Barnett, however, only discloses redeeming the coupons electronically. The examiner argues that Barnett teaches that the coupons are redeemed without human intervention (answer, page 6), but such a disclosure does not appear in Barnett.

The examiner argues that "automatically" means "as done or produced as if by machine", and "electronically" means "implemented on or by means of a computer" (answer, page 6). Even if the examiner's definitions are correct, the examiner's argument is not persuasive because something can be implemented on or by means of a computer in response to human intervention.

Thus, the examiner has not established that Barnett discloses redeeming coupons automatically. Nor has the examiner explained how Barnett's disclosure of redeeming coupons electronically would have fairly suggested redeeming coupons automatically to one of ordinary skill in the art.

Consequently, we conclude that the examiner has not established a prima facie case of obviousness over Barnett in view of Bezos.[2]

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[2] The examiner does not rely upon Bezos for any disclosure that remedies the above-discussed deficiency in Barnett.

DECISION

The rejections of claims 61-63 under the judicially created doctrine of obviousness-type

double patenting over 1) claims 1-16 of Golden in view of Barnett and Bezos, and 2) claims

1-16 of Levin in view of Barnett and Bezos, are affirmed. The rejection of claims 61-63 under

35 U.S.C. § 103 over Barnett in view of Bezos is reversed.

AFFIRMED

TERRY J. OWENS   )
Administrative Patent Judge)
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)   BOARD OF PATENT
STUART S. LEVY   )   APPEALS AND
Administrative Patent Judge)   INTERFERENCES
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